

REMARKS

The undersigned attorney wishes to thank the Examiner for the courtesies extended during the Interview. During the Interview, the Examiner agreed that the amendments to claims set forth above, in addition to filing a terminal disclaimer to overcome the provisional double patenting rejection, will place the application in condition for allowance.

Claims 12-15 have been amended to replace the "gene" with the term --polynucleotide--. Support for this amendment is found in the specification at, for example, page 3, ¶¶ [0016]-[0017] and page 10, ¶¶ [0041]-[0043].

Claims 12 and 13 have further been amended to replace the term "comprises" with --consists essentially of--. Support for this amendment is found in the specification at, for example, page 10, ¶¶ [0041]-[0043].

It is submitted that no new matter has been introduced by the foregoing amendments. Approval and entry of the amendments is respectfully solicited.

§112, First Paragraph Written Description Rejection

Claims 12-15 were rejected under 35 USC §112, first paragraph. (Paper No. 04252004 at 2). In making the rejection, the Examiner asserted that the "partial sequences/fragments of SEQ ID NO: 2 is [sic] claimed with open language and the genus encompasses a variety of species with widely varying attributes," thus the Examiner reasoned that "the specification is insufficient to put one of skill in the art in possession of the features of all species within the claimed genus." (*Id.* at 3).

With a view towards furthering prosecution, and as suggested by the Examiner during the Interview, claims 12 and 13 have been amended as set forth above. Accordingly, it is respectfully submitted that the rejection is rendered moot and should be withdrawn.

Provisional Obviousness-Type Double Patenting Rejection

Claims 6-7, 10-15, 19-27, 31, 32 and 37 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-15, 19-32 and 34-36 of copending parent Application Serial No. 09/504,393. (Paper No. 04252004 at 4).

In making the rejection, the Examiner asserted that “[a]lthough the conflicting claims are not identical, they are not patentable distinct from each other because they are drawn to identical nucleic acid sequences encoding the same protein, identical primers/probes, identical kits comprising said primer/probe, identical methods of using said nucleic acid sequence and vectors and host cells comprising said nucleic acid sequence.” (*Id.*)

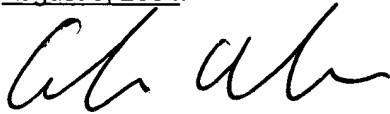
With a view towards furthering prosecution, submitted concurrently herewith and expressly contingent upon the issuance of the ‘393 application is a terminal disclaimer disclaiming the terminal part of any patent granted on the present application that would extend beyond the expiration of the patent granted on the ‘393

Application No.: 10/053,192
Amendment Dated: August 3, 2004
Reply to Office Action Dated: May 4, 2004

application.^{1/} Accordingly, it is respectfully submitted that the provisional rejection is rendered moot and should be withdrawn.

Accordingly, for the reasons set forth above, entry of the amendments, withdrawal of all rejections, and allowance of all claims are respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Box Amendment, Commissioner for Patents, P.O. Box. 1450 Alexandria, VA 22313-1450, on August 3, 2004.



Gonzalo Merino, Ph.D., Reg. No. 51,192

Respectfully submitted,

By: 

Gonzalo Merino, Ph.D.
Reg. No. 51,192
BRYAN CAVE LLP
1290 Avenue of the Americas
New York, NY 10104-3300
Phone: (212) 541-2000
Fax: (212) 541-4630

^{1/} As a courtesy, a copy of the terminal disclaimer as filed is attached hereto as Exhibit A.